



Atty. Dkt. No. 036390-0102

IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John L. Jorstad et al.

Title: PROCESS FOR GENERATING A
SEMI-SOLID SLURRY

Appl. No.: 10/715,362

Filing Date: 11/19/2003

Examiner: Tran, Len

Art Unit: 1725

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the election of species requirement mailed on August 9, 2004, Applicants elect with traverse "species" I, claims 1-28, directed to a method of molding by combining a first and a second metal.

The traverse is on the ground that the alleged "species" were improperly identified in the Office Action. Specifically, the election of species requirement is improper because it violates the rule set forth in MPEP § 806.04(f). MPEP § 806.04(f) states that "claims to be restricted to different species must recite mutually exclusive characteristics of such species" (emphasis added). However, this condition is not met in the present application.

For example, claim 1 recites a molding method including providing a first solid metal portion and a second liquid metal portion in a first chamber. Claims 29 and 44 recite a molding method comprising providing a solid metal heat sink and liquid metal into a chamber. Applicants note that the solid metal heat sink recited in claims 29 and 44 is a species of the solid metal genus recited in claim 1. In other words, claim 1 is a generic claim, while claims 29 and 44 are species claims of the genus of claim 1. Therefore, the method of

claim 1 is not mutually exclusive from the methods of claims 29 and 44 and cannot be part of a different species. Thus, claims 1, 29 and 44 are not part of distinct species because they do not satisfy the condition in MPEP § 806.04(f) that claims to be restricted to different species must recite mutually exclusive characteristics of such species.

Applicants further note that dependent claims 4 and 16 which depend from claim 1 recite a grain refining agent. Therefore, claims reciting a grain refining agent cannot be considered to be part of distinct species from claims reciting solid and liquid metal (such as claim 1) or from claims reciting a solid heat metal sink and liquid metal (such as claim 29) because the grain refining agent is not a mutually exclusive characteristic from the solid and liquid metal in a chamber.

Applicants respectfully request that the election of species requirement be withdrawn and that claims 1-57 be examined on the merits together. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date September 9, 2004 By Thomas J. Glodek <sup>Reg. No.
43,438</sup>

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Leon Radomsky
Attorney for Applicant
Registration No. 43,445

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, postdated, otherwise improper or informal or even entirely missing, the Commissioner is unauthorized to charge the unpaid amount to Deposit Account No. 19-0741.